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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,722	03/21/2001	Sylvain Chevreau	PF 980065	6135

7590 07/14/2004

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Thomson Multimedia Licensing Inc
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EXAMINER

AKPATI, ODAICHE T

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 07/14/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application

09/787,722

Applicant(s)

CHEVREAU ET AL.

Examiner

Tracey Akpati

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION***Specification***

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should

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be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.

- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 recites the limitation "said digital data" in the claim language or are dependent on a claim that recites the above limitation. There is insufficient antecedent basis for this limitation in the claim(s).

Claim Objections

Claim 9 is objected to under 37 CFR 1.75(c) as being in improper form because of it having a multiple dependency on claims 2 and 3. See MPEP § 608.01(n). Accordingly, the Claim 9 has not been further treated on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Linnartz (6314518

B1).

With respect to Claim 1, the limitation of “a method of protection against the copying of digital data stored on an information carrier consisting in delivering a permission or a prohibition to copy and/or to play said digital data as a function of the identification or otherwise of at least two elements from: an encryption of said digital data; a watermarking of said digital data; a recordable or non-recordable type of said information carrier; a cryptographic signature accompanying said digital data” is met by the abstract.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6, 8, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz (6314518 B1).

With respect to Claim 2, the limitation of “an encryption of said digital data has been identified” is met on column 8, lines 38-41; and “a watermarking of said digital data has been identified” is met on column 8, lines 43-49; and “a non-recordable type of carrier has been identified” is met on column 4, lines 14-18. This citation implies that the system is sensitive to the type of medium used and hence making the sensitivity to a non-recordable type of carrier obvious. Further limitation of “a cryptographic signature accompanying said digital data has been identified” is met on column 8, line 67 and column 9, line 1.

It would have been obvious to one of ordinary skill in the art at the time of the invention to deliver permission for digital copying even when a non-recordable type of carrier is identified because the presence of a watermark embedded within the encrypted content and a signature attached to it already verifies the originality/authenticity of the content.

With respect to Claim 3, the limitation of “a permission for digital copying is delivered when an encryption of said digital data has not been identified” is met inherently on column 4, lines 54-59. This is because the cited reference does not disclose video content as encrypted and hence it implies that the content is indeed unencrypted. The limitation of “a watermarking of said digital data has not been identified” is met on column 5, lines 4-10.

With respect to Claim 4, the limitation of “wherein a prohibition of playing of said digital data is delivered when an encryption of said digital data has not been identified” is met inherently on column 1, lines 40-47; and a watermarking of said digital data has been identified” is met on column 1, lines 47-52.

With respect to Claim 5, the limitation of “wherein a prohibition of copying is delivered when an encryption of said digital data has been identified” is met inherently on column 3, lines 65-67. Hence the content is encoded/encrypted form. Further limitation of “a watermarking of said digital data has been identified; and a recordable type of carrier has been identified” is met on column 4, lines 1-4.

With respect to Claim 6, the limitation of “wherein a prohibition of copying is delivered when an encryption of said digital data has been identified” is met on column 2, lines 34-38; and “a watermarking of said digital data has been identified” is met on column 2, lines 20-31; and “a non-recordable type of carrier has been identified” is met on column 4, lines 14-18; and “no cryptographic signature accompanying said digital data has been identified” is met inherently on column 2, lines 34-38. This is because when the digital signature is verified, the absence of a signature or presence of an invalid signature will prevent a positive authentication from taking place.

With respect to Claim 8, the limitation of “wherein the prohibition of digital copying comprises a blocking of output of the digital data” is met inherently on column 4, lines 1-3.

With respect to Claim 9, the limitation of “a digital output for delivering signals representative of the digital data upon playing said digital data; an analog output for delivering analog signals representative of the digital data upon playing said digital data” is met on column 1, lines 18-21; and “means for detecting an encryption of said digital data” is met on column 8, lines 38-41; and “a watermarking of said digital data” is met on column 8, lines 43-44; and “a recordable or non-recordable type of said information carrier” is met by column 4, lines 14-18; and “a cryptographic signature accompanying said digital data” is met on column 8, line 67 and column 9, line 1; and “a system for decrypting said digital data when an encryption is detected” is met on column 8, lines 38-41; and “a system for protection against the copying of said digital data receiving signals from said detection means and generating a copy permission signal or a

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copy prohibition signal” is met by the abstract. Further limitation of “recording control means blocking the signals delivered at the digital output when said control means receive a copy prohibition signal from the protection system” is met inherently on column 4, lines 1-3; and “a system for protection of playing receiving signals from said detection means and generating a playing prohibition signal” is met inherently on column 4, lines 1-3; and “playing control means interrupting the playing of the data or their output to the analog output when said monitoring means receive a playing prohibition signal from the protection system” is met inherently on column 4, lines 1-3.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz (6314518 B1) in view of Linnartz (6209092 B1).

With respect to Claim 7, all the limitation is met by Linnartz ‘518 except the following limitation.

The limitation of “a conversion of the digital data into analog signals and a corruption of the analog signals if a prohibition of digital copying is delivered” is met implicitly by Linnartz ‘092 on column 2, lines 10-14 and on column 3, lines 9-16.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Linnartz ‘092 within the system of Linnartz ‘518 because corruption of the analog signals upon playback will directly prevent an unauthorized user from utilizing an already bootlegged copy of content.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracey Akpati whose telephone number is 703-305-7820. The examiner can normally be reached on 8.30am-6.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 703-305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OTA

Tracey Akpati
AU 2135